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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,392	04/28/2000	Michael Wayne Brown	AUS000029US1	3336
42640	7590	12/13/2005	EXAMINER	
DILLON & YUDELL LLP 8911 NORTH CAPITAL OF TEXAS HWY SUITE 2110 AUSTIN, TX 78759			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/560,392	Applicant(s) BROWN ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-49, 51-55 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-49 and 51-55 and 57-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 45-49, 51-55, and 57-59 have been examined.

Response to Amendment

2. The Amendment filed on 11/30/05 is insufficient to overcome prior rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 45-49, 51-55, and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klug (6,823,327) in view of Meyer (6,915,271) in view of Gardenswartz (6,055,573).

Claims 45, 48, 49, 51, 54, 55, 57: Klug discloses a method, system, program for automatically electronically registering a user with a plurality of consumer providers, said method comprising the steps of:

receiving at each of a plurality of server systems a user profile comprising a plurality of profile elements transmitted in a particular transmittable data format for a particular user from a portable computer system, wherein each of said plurality of server systems is respectively associated with one of a plurality of consumer providers;

Art Unit: 3622

inserting each of said plurality of profile elements respectively into a specified plurality of electronic registration elements required for electronic registration at a particular server system from among said plurality of server systems; and

transmitting a registration indicator for said particular user from said particular server system to said portable computer system in said particular transmittable data format, such that said particular user is automatically registered with said plurality of consumer providers by transmitting said single user profile to said plurality of server systems; and

transmitting a registration information from said particular server system to said portable computer system (Abstract; Fig. 1; Fig 2; Fig. 3; Fig. 5; Fig. 6 ; Fig. 9).

Klug further discloses that the user registration information with indicators of who the user has successfully registered with can be stored at the user device (Fig. 1; col 6, lines 27-35).

Klug further discloses user profile information (Fig. 3).

Klug discloses that the user utilizes the Internet and browsers and computers (Fig. 1).

Klug does not explicitly disclose the utilization of cookies, a portable computer, or targeting.

However, Meyer discloses registering a user or the user becoming a member (col 2, lines 6-15; col 16, lines 25-30), that the user device can be portable (), that a registration indicator such as a cookie can be stored on the user device (col 8, lines 17-25), and that XML can be utilized (col 39, lines 25-30; col 53, lines 9-20).

Meyer further discloses automatically filtering a plurality of products and services offered by said particular consumer provider according to said user profile for said particular user; and

Art Unit: 3622

transmitting a specified offering from among said plurality of products and services to said portable computer system for said particular user (col 2, lines 29-46; col 3, lines 30-41; col 4, line 60-col 5, line 9).

Gardenswartz further discloses targeting a user and a user registering (col 3, lines 30-45), and utilizing the Internet (Fig. 1), and utilizing a portable computer device (col 11, lines 55-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gardenswartz's portable computer and Meyer's utilizing profile information for targeting and utilizing standard Internet technologies such as cookies and XML to Klug's utilizing the Internet and collecting of user profile information given to third party websites. One would have been motivated to do this in order to utilize the further location flexibility and convenient technical qualities of the Internet and to make better use of known user information for sending information of more likely interest to the user.

Additionally, the combination of the prior art renders obvious:

Generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems;

Transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems;

Receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system;

Art Unit: 3622

Wherein said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements specifying a consumer preference in response to a receipt of said request at said portable computer system.

Klug discloses generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems (Klug, Fig. 1);

Receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system (Klug, Fig. 1).

Klug further discloses determining at the user computer based on user preferences which server to communicate with:

“(10) In either embodiment, the present invention may also provide a "mass" registration capability, wherein a user may request that the present invention automatically register the user at a plurality of web sites. For example, the user may be provided with a capability to search for web sites cooperating with the present invention by, for example, category and request an automatic registration at multiple web sites substantially simultaneously” (col 2, line 65-col 3, line 7).

Klug further discloses utilizing personal information, location information

“(4) Thus, in order to obtain these web site measurements, such web sites have begun requesting that each user provide information about himself/herself prior to the web site allowing access to web site services. That is, such web sites require a user to "register" at the web site, wherein the user is required to establish a user identification (user ID) and optionally a

Art Unit: 3622

password with the web site as well as typically provide personal information such as, for example, the city of residence or family size" (col 1, lines 45-56).

Klug further discloses targeting users based on preferences:

"Further, such third party web sites 116 may periodically provide the registrar web site 100 with information related to the frequency that users registered at the registrar web site 100 have accessed the third party web sites 116. Therefore, by also storing this information, for example, in the registrar access log 152, the registrar web site 100 is able to determine the frequency and type of access of third party web sites 116 by users" (col 5, lines 45-55)

Klug further discloses that the user is requested to provide information:

"(4) Thus, in order to obtain these web site measurements, such web sites have begun requesting that each user provide information about himself/herself prior to the web site allowing access to web site services. That is, such web sites require a user to "register" at the web site, wherein the user is required to establish a user identification (user ID) and optionally a password with the web site as well as typically provide personal information such as, for example, the city of residence or family size (col 1, lines 45-56).

FIGS. 6A and 6B provide a flowchart of the steps performed when supplying a third party web site 116 with registration information from the registrar web site 100, assuming that the third party web site has requested such information and that the request has been authenticated at the registrar web site 100 (col 3, lines 42-48);

Thus, the third party web site 116 requests and receives the user's registration information from the registrar web site 100 and stores the user's registration information in registration information database 148 directly accessible by the third party web site 116. Additionally

Art Unit: 3622

note that when the registrar web site 100 receives a request from the third party web site 116 for user registration information, a registrar application 128 records the request for the user's registration information in a registrar access log data base 152. Thus, the registrar web site 100 maintains a log of the third party web sites requesting registration information. Further, such third party web sites 116 may periodically provide the registrar web site 100 with information related to the frequency that users registered at the registrar web site 100 have accessed the third party web sites 116. Therefore, by also storing this information, for example, in the registrar access log 152, the registrar web site 100 is able to determine the frequency and type of access of third party web sites 116 by users (col 5, lines 35-55).

(11) Referring now briefly to FIG. 3, this flowchart presents the steps a user performs when entering web site registration information into the fillout forms to be submitted to registrar. Accordingly, in step 304 the user determines whether to supply basic information (i.e., requested by a substantial number of third party web sites 116) as described in step 308 or to supply expanded information (i.e., more extensive information about the user so that, for example, registrar has sufficient user information to register the user at substantially all cooperating third party web sites 116). Note that at least in one embodiment, the basic information supplied in step 308 (i.e., the user's name, e-mail address, gender and date of birth) is also requested in the forms for expanded information in step 312 (col 8, lines 40-55).

Accordingly, assuming the user uses a WWW browser 120 to access a third party web site 116 as in step 404, the third party web site responds with a web site home page (step 408) typically having a registration fill-out form into which the user is requested to enter registration

Art Unit: 3622

information. Note that the user may or may not be registered at this third party web site (col 9, lines 10-16).

Note that a third party web site 116 may request various categories of information from the registrar web site 100 related to the user. In particular, a third party web site may request: (a) basic information as discussed in step 308 of FIG. 3; (b) expanded information as discussed in step 312 of FIG. 3; (c) custom information, wherein selected fields from the basic and expanded information are provided; and (d) proprietary information wherein one or more additional user related information items may be provided wherein these items have been obtained by the registrar web site 100 by, for example, enriching and verifying the registration information obtained from the user as in step 256 of FIG. 2B". (col 10, line 58-col 11, line 5).

Klug does not explicitly disclose utilizing proximity to determine whether or not to communicate with a user.

However, Meyer discloses utilizing location/geographic information to determine whether or not communicate with a user:

"(53) One implementation of the system includes means for transmitting targeted information about incentives to the member, including targeted information about a clipped incentive. Such information may be that the incentive may soon expire, information that the incentive's value has changed, information on related incentives, and/or information that there are related incentives new since the last clipping. The means for transmission includes one or more of means for sending e-mail, means for making a telephone call, means for sending postal mail, means for placing the targeted information on particular locations related to the member, means for displaying the targeted information whenever the member views an

Art Unit: 3622

incentive, means for displaying the targeted information whenever the member clips an incentive. The transmitting targeted information may include publishing additional selection means or programming existing selection means to select incentives according to targeting criteria related to one or more characteristics of the member (col 12, lines 45-63).

(152) Many prior art systems for electronic distribution of promotional incentives store in an incentive the address and other identifying information of a consumer clipping the incentive. Because of the way incentives are redeemed in the preferred embodiment, there is no need to know the geographical location of the member. For using an online merchant, there is never a need for the system to know any geographical locations. For example, it is not the geographical location, but rather the "hypergeographical" location (the URL) of the member that is stored as part of an incentive instance. In an alternate embodiment, the geographic locations also can be added as one of the parameters stored. In another alternative offline merchant redemption method, the offline merchant system logs on to the service provider process SRVPRVD at predetermined times (e.g., every midnight), either via the Internet or directly over telephone lines, and receives an update of all the incentives (including member IDs) for all members who have clipped incentives. When a geography factor is included, this may be restricted to the members IDs for all members in the geographical are of the offline merchant" (col 43, line 65-col 44, line 20).

Also, Gardenswartz discloses utilizing location/geographic information to determine whether or not communicate with a user:

"(61) In step 1010, the registration server 14 presents the consumer with a reward for fulfilling the value contract. Delivery of the reward may be conditioned on the behavior of the

Art Unit: 3622

consumer. For example, acceptance of the reward may require that the consumer to visit a specified retail location such as a specific grocery store. Accordingly, the value contract can be implemented to provide the consumer with an incentive to visit selected locations. The locations may be selected on the consumer's preestablished shopping habits (e.g., the grocery store that the consumer frequents most often), as determined from the master record corresponding to the consumer in the purchase history database 8. After step 1010, the process proceeds to step 1014" (col 16, lines 35-50).

And, Meyer discloses the user device receiving a request for profile information and the user device determines what information to provide or not in response to the request:

"Another technique involves transmitting from a server computer to a client computer a request for a user's personal profile information, and activating a client avatar that compares the request for personal profile information with a security profile of the user limiting access to personal profile information" (col 3, lines 60-67).

Also, both Meyer and Gardenswartz disclose utilizing cookies to store consumer preference information on the user computer.

Gardenswartz further discloses utilizing user preference information to determine what to communicate to the user or not:

"The online profile may include information such as the consumer's name CID, e-mail address, product/brand preferences, demographic information, work address, home address, whether the consumer has any babies, and whether the consumer has any pets such as a cat, dog, bird, or fish. Preferably, the online profile includes at least one item of information

Art Unit: 3622

that is stored (or is to be stored) in the purchase history database 8. While referred to as an online profile, the profile may be generated or obtained on an offline basis, such as by filling out a card in a grocery store, for example. Other forms of registration may include a consumer entering registration information at a kiosk in the grocery store after scanning the bar code or alternatively swiping the magnetic strip of his or her shopper loyalty card through a magnetic strip reading device. The profile preferably includes information of how to transmit by computer information to the consumer, such as the consumer's e-mail address, IP (Internet protocol) address, or any information which may be used to electronically send information to the consumer, including, for example, through a paging device or a portable computer (col 11, lines 42-65).

(78) Accordingly, steps 1100 through 1112 may be implemented to engage in different targeted messages with different classifications of consumers. Since the classifications are based on the offline purchase history of the consumers, the targeted messages can be targeted based on the consumers offline tastes and preferences. If the targeted messages are interactive messages, the flexibility of the interactive messages permits each different message to be tailored based on the inputs received from consumer, further enhancing the degree to which advertisements and offers can be targeted" (col 20, lines 40-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Meyer and Gardenswartz's utilizing proximity to determine whether or not to communicate to a user to Klug's communicating with a user, targeting a user, and user location information. One would have been motivated to do this in order to communicate with the user when the information may be of higher relevance to the user.

Claim 46, 52, 58: Klug and Meyer and Gardenswartz disclose the above and Klug further discloses storing said electronic registration in association with said particular registration indicator at said particular server system (Abstract; Fig. 1; Fig 2; Fig. 3; Fig. 5; Fig. 6; Fig. 9).

Claim 47, 53, 59: Klug and Meyer and Gardenswartz discloses the above and Klug further discloses that in response to receiving said registration indicator at said particular server system, retrieving said electronic registration for said particular user (Abstract; Fig. 1; Fig 2; Fig. 3; Fig. 5; Fig. 6; Fig. 9).

Response to Arguments

Applicant's arguments with respect to claims 45-49, 51-55, and 57-59 have been considered but are not considered persuasive. Please particularly note the section added above in the rejection of the Independent claims that starts with, "Additionally, the combination of the prior art renders obvious: Generating a request to transmit a plurality. . ." thru to the rejection of the independent claims.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being

Art Unit: 3622

referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Goldhaber (5,794,210) discloses determining to communicate with a user based on location and using user profile elements to determine whether to communicate or not (see Goldhaber, limited citation below):

“(10)... In print media, advertisers choose magazines and newspapers whose editorial policies or geographic coverage attract readers likely to be interested in the advertisers'products. These techniques allow the advertisers to "target" their advertisements to a subset of the general population that may be more likely to respond to the advertisements.

(73) There can be many attention brokerage servers 106. Each attention brokerage server may serve a specific interest area (e.g., opera, winter sports, etc.), a specific geographic area, a specific demographic area, or any combination of these”.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

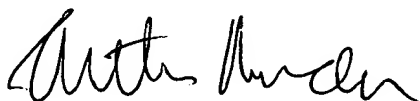
Art Unit: 3622

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
12/7/2005